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PATENT APPLICATION

RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2133



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Shinichiro TANIGUCHI et al.

Group Art Unit: 2133

Application No.: 09/454,865

Examiner: C. Colin

Filed: December 7, 1999

Docket No.: 104934

For: DISTRIBUTION INFORMATION MANAGEMENT SYSTEM AND METHOD

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

Technology Center 2100

In reply to the March 29, 2004 Office Action, reconsideration of the rejection is respectfully requested in view of the following remarks. Claims 1-27 are pending.

I. The Claims Define Patentable Subject Matter

The Office Action rejects claims 1-27 under 35 U.S.C. §103(a) over Misra (U.S. Patent No. 6,189,146). The rejection is respectfully traversed.

In particular, Misra does not disclose or suggest a distribution information processing module including a reading part that reads out the data of the data carrier and a storing part that stores the information in the data carrier, as recited in independent claim 1 and similarly recited in independent claims 20, 22, 24 and 26.

The Office Action asserts that in the previous October 23 Office Action, that Office Action does not state that the license generator reads information, but that Misra at col. 8, lines 35-67 does disclose a reading part that reads information.

In the December 30, 2003 Amendment, Applicants argued that Misra does not disclose or suggest a distribution information processing module including a reading part that reads out the data of the data carrier, and a storing part that stores information in the data carrier.

Specifically, Applicants argued that Misra's license generator writes information into the license pack but does not read the information in the license pack. Rather, Applicants argued that a separate license server reads that information stored in the license pack.

It appears that the Office Action is asserting that the separate license server may be combined with the license generator to render the above-noted claims obvious. Applicants respectfully submit that the license generator and the separate license server may not be combined to render the claims obvious for the reasons as follows:

Misra addresses a method to effectively monitor software licensing to ensure that the terms of the licensing agreement are met (see col.2, lines 6-9). As part of this method, Misra discloses at Fig. 1 and at col. 3, 63-67 that the clearinghouse 22 is separate from the company 24. As shown in Fig. 1, the license generator 26 resides in the clearinghouse 22 and the license server 28 resides in the license server 28. Contrary to that asserted in the Office Action above, that is, the license generator 26 and the license server 28 may be combined, Misra teaches away combining the two because combining the two would defeat the purpose of effectively monitoring the licensing agreement.

For example, at col. 2, lines 11-16, Misra discloses that the license generator 26 provides confidence to the software vendor that the software license is complied. The license server assist the purchaser in monitoring its own compliance with the license. Thus, Misra

does not provide for the teaching, suggestion or even motivation for one skilled in the art to combine the two.

Further, if the license generator 26 and the license server 28 were to be combined, Mirsa's purpose, i.e., addressing the problem of software compliance, would be meaningless.

For example, the license generator 26 assigns a unique license pack ID to the license pack and associates the license pack ID with the license server 28 (see col. 2, lines 36-41). The license server 28 verifies the license generator's digital signature on the license pack and if valid, installs the license pack for subsequent distribution of licenses (see col. 2, lines 48-50). Thus, if the license generator 26 and the license server 28 were to be combined together, there would be meaningless for the license generator 26 to generate a unique pack ID and there would be meaningless for the license server 28 to verify the license generator's digital signature when they are in the same unit.

Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness. MPEP 706.02(j) is clear in that to establish a *prima facie* case of obviousness, three basic criteria must be met, one of which is that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Here, this criteria has not been met.

Furthermore, Applicants respectfully submit that "It is impermissible for an examiner to engage in hindsight reconstruction of the claimed invention using appellant's structure as a template and selecting elements from references to fill the page. The references themselves must provide some teaching whereby the appellant's combination would have been obvious." In re Gorman, 911 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir, 1991).

Accordingly, withdrawal of the rejection of independent claims 1, 20, 22, 24 and 26 is respectfully requested.

Furthermore, Misra does not disclose or suggest a data carrier that stores distribution information of the article generated for each one or one set of transactions in the distribution process of the article, and at least a part of the signature value of at least part of a piece of the distribution information or at least part of each of serial pieces of the distribution information, as recited in independent claim 18.

The Office Action asserts that Misra at col. 15-16 discloses that the license server updates and stores information since Misra discloses that the license server adds a record to the client assignment table.

On the contrary, the claim recites a data carrier that stores distribution information of the article generated for each one or one set of transactions in the distribution process of the article. In Misra, as shown in Fig. 3 and disclosed at col.15, lines 25-28 and at col. 9, 36-61, the license pack table 114 and the client assignment table 116 at both located in the license server 28, and not in the license pack 108 (which the Office Action associates with the claimed data carrier), in which transactions are being stored.

Furthermore, Misra does not disclose or suggest a distribution information management module that reads/stores the information out/in a data carrier attached to an article for storing the information relative to the article and communicates the information with a distribution information processing module for processing the information relative to distribution of the article to manage the information relative to the article, as recited in independent claim 21 and similarly recited in independent claims 23, 25 and 27.

Misra does not disclose or suggest the above-noted features for at least the reasons stated with respect to claim 1.

Therefore, independent claims 1, 18, 20 and 21-27 define patentable subject matter. Claims 2-17 and 19 depend from the respective independent claims, and therefore also define

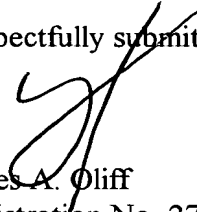
patentable subject matter. Accordingly, withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

II. Conclusion

In view of the foregoing amendments and remarks, this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-27 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,


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Date: April 30, 2004

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